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29159 7590 08/27/2007 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690			EXAMINER HOEL, MATTHEW D	
			ART UNIT 3714	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary

Application No.

10/655,871

Applicant(s)

HUGHS-BAIRD ET AL.

Examiner

Matthew D. Hoel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 15-19, 32-46 and 51-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-11, 20-28 and 47-50 is/are rejected.
- 7) ☒ Claim(s) 5-7, 12-14 and 29-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/27/04, 2/14/05, 7/28/05, 2/24/06, 5/14/07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

2. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1 to 4, 8 to 11, 20 to 23, 25 to 28, and 47 to 50 are rejected under 35 U.S.C. 102(a) as being obvious over "The Price is Right Dice Game" (8-22-2004 archived web page of <http://gscentral.net/dice.htm>, downloaded from <http://web.archive.org/web/20040822075604/http://gscentral.net/dice.htm> on 8-19-2007, hereafter referred to as Dice Game) in view of Baerlocher, et al. (U.S. patent 6,406,369 B1).

5. As to Claim 1: Dice Game teaches a plurality of component symbols (top and bottom rows of digits, Pages 1 and 2); a plurality of prediction symbols (plural dice Pages 1 and 2). Dice game teaches a game to (a) select one of said component

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symbols (first symbol selected, Page 2); (b) designate one of said plurality of prediction symbols (dice rolled, Page 2); (c) display said designated prediction symbol to a player (dice displayed, Page 2); (d) change a first modifier based on said displayed prediction symbol (thousands place revealed to player if dice matches digit for that price Page 2, the digit is a X1000 modifier since it is a thousands decimal place in the price of a car, in this case the 3 would have been revealed to the player in the thousands position if the car were in the \$3,000 to \$3,999 range, but it was not so in this case the player had to select higher or lower than three and correctly selected higher so a four was shown in the thousands place; in the example of Page 2 the prediction symbol or dice correctly predicted the component symbol or 6 in the tens place to the player did not have to select higher or lower); (e) change a second modifier if said prediction symbol matches said selected component symbol (process repeated and hundreds place revealed to player if dice matches digit for that price Page 2); (f) if said prediction symbol does not match said selected component symbol: (i) form at least two symbol sets based on said prediction symbol, wherein one of said symbols sets includes the selected component symbol (player must select from higher or lower as outlined above concerning Page 2 of the Price is Right Dice Game, in this case the player had to select higher or lower in the 1000s, 100s and 1s places because the 3, 4, and 5 of the dice did not match the 4, 6, and 8 digits, respectively); (ii) enable the player to input a prediction of which formed symbol set includes the selected component symbol; (iii) reveal the selected component symbol to the player; and (iv) change a third modifier if the player correctly picked which symbol set includes the selected component symbol (player has to select last digit as

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higher or lower than five rolled on dice or prediction symbol in ones place of car price on Page 2, player correctly selected higher so 8 digit is revealed to player);

(g) repeat steps (a) to (f) until each of said component symbols is revealed; and (h)

provide the player an award based on said first modifier, said second modifier and said third modifier (game repeated until all digits are revealed and prize awarded to player in

the event the player got all of the digits right, Pages 2 and 3). Dice game, however,

lacks specificity as to a gaming device comprising: a display device; and a processor operable with said display. '369, however, teaches an analogous game comprising a

gaming device, a processor, and a display (Abst., Fig. 1, 2). It would have been

obvious to one of ordinary skill at the time the invention was made to have applied the

game of Dice Game to a wagering gaming device such as '369. MPEP 2144.04(III): "III.

AUTOMATING A MANUAL ACTIVITY. In re Venner, 262 F.2d 91, 95, 120 USPQ 193,

194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus

for molding trunk pistons were allowable over the prior art because the claimed

invention combined "old permanent-mold structures together with a timer and solenoid

which automatically actuates the known pressure valve system to release the inner core

after a predetermined time has elapsed." The court held that broadly providing an

automatic or mechanical means to replace a manual activity which accomplished the

same result is not sufficient to distinguish over the prior art.)." The applicants' prior art

(102(b)) teaches a TV game show implemented as a bonus game on a wagering device

(U.S. patent 5,788,573 A) which would suggest taking a TV game show such as the

Price is Right Dice Game and making it a bonus game on a wagering device. '369 is

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analogous art to Dice Game in that it has ranges of action for the player (pass left or pass right, Fig. 5) and cumulative modifiers (Fig. 3). The advantage of this combination would be to take a game show familiar to players, most likely over thirty because of the running dates of the Price is Right game show, to attract players to play an otherwise typical slot machine.

6. As to Claim 2: Dice Game on Page 2 shows the 6 in the tens place being revealed by the six on the dice (prediction symbol) matching the actual value of that digit.

7. As to Claim 3: The component symbols in Dice Game are from a range of numbers (higher or lower than the dice prediction symbol, Page 2).

8. As to Claim 4: The plurality of component symbols in Dice Game form a target symbol (plurality of digits forming the price of the car, Page 2).

9. As to Claim 8: ' 369 teaches a gaming device comprising: a primary wagering game operable upon a wager by a player (Figs. 1, 2; 4:50-5:15). Dice Game teaches a plurality of component symbols; a plurality of prediction symbols (Pages 2 and 3); and a triggering event associated with said primary wagering game. Dice Game teaches (a) one of said component symbols is selected (one of digits is selected, Page 2); (b) one of said plurality of prediction symbols is designated (dice or prediction symbol rolled for each digit, Page 2); (c) said designated prediction symbol is displayed to the player (Page 2); (d) a first modifier is changed based on said displayed prediction symbol (thousands place revealed to player if dice matches digit for that price Page 2, the digit is a X1000 modifier since it is a thousands decimal place in the price of a car, in this

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case the 3 would have been revealed to the player in the thousands position if the car were in the \$3,000 to \$3,999 range, but it was not so in this case the player had to select higher or lower than three and correctly selected higher so a four was shown in the thousands place); (e) a second modifier is changed if said prediction symbol matches said selected component symbol (process repeated and hundreds place revealed to player if dice matches digit for that price Page 2); (f) if said prediction symbol does not match said selected component symbol: (i) at least two symbol sets are formed based on said prediction symbol, wherein one of said symbols sets includes the selected component symbol (player must select from higher or lower as outlined above concerning Page 2 of the Price is Right Dice Game); (ii) the player is enabled to input a prediction of which formed symbol set includes the selected component symbol; (iii) the selected component symbol is revealed to the player; and (iv) a third modifier is changed if the player correctly picked the symbol set which includes the selected component symbol (player has to select last digit as higher or lower than five rolled on dice or prediction symbol in ones place of car price on Page 2, player correctly selected higher so 8 digit is revealed to player); (g) steps (a) to (f) are repeated until each component symbol is revealed; and (h) an award based on said first modifier, said second modifier and said third modifier is provided to the player (game repeated until all digits are revealed and prize awarded to player in the event the player got all of the digits right, Pages 2 and 3).

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10. As to Claim 9: Dice Game on Page 2 shows the 6 in the tens place being revealed by the six on the dice (prediction symbol) matching the actual value of that digit.
11. As to Claim 10: The component symbols in Dice Game are from a range of numbers (higher or lower than the dice prediction symbol, Page 2).
12. As to Claim 11: The plurality of component symbols in Dice Game form a target symbol (plurality of digits forming the price of the car, Page 2).
13. As to Claim 20: As outlined regarding Claim 1, '369 and Dice Game teach a gaming device comprising: a plurality of symbols; a plurality of component symbols, wherein each component symbol is one of said plurality of symbols; a plurality of symbol sets, wherein each symbol set includes zero, one or a plurality of said symbols; a plurality of different modifiers; a display device; and a processor operable with said display device to select at least 10 one of said component symbols and for each selected component symbol to: (a) designate one of said plurality of symbols as a prediction symbol; (b) display said designated prediction symbol to a player; (c) provide the player an award based on said selected component symbol and one of the modifiers if said prediction symbol matches said selected component symbol, wherein each time said prediction symbol matches said selected component symbol the award is based on a different one of said modifiers; and (d) if said prediction symbol does not match said selected component symbol: (i) form at least two of said symbol sets based on said prediction symbol, wherein one of said symbols sets includes the selected component symbol; (ii) display the symbols from the symbol set including the selected component

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symbol; (iii) enable the player to try to pick the selected component symbol by picking one of the displayed symbols; (iv) reveal the selected component symbol to the player; and (v) provide the player said award if the player correctly picked the selected component symbol (top and bottom rows of digits, Pages 1 and 2; plural dice Pages 1 and 2; first symbol selected, Page 2; dice rolled, Page 2; dice displayed, Page 2; thousands place revealed to player if dice matches digit for that price Page 2, the digit is a X1000 modifier since it is a thousands decimal place in the price of a car, in this case the 3 would have been revealed to the player in the thousands position if the car were in the \$3,000 to \$3,999 range, but it was not so in this case the player had to select higher or lower than three and correctly selected higher so a four was shown in the thousands place; in the example of Page 2 the prediction symbol or dice correctly predicted the component symbol or 6 in the tens place to the player did not have to select higher or lower; process repeated and hundreds place revealed to player if dice matches digit for that price Page 2; player must select from higher or lower as outlined above concerning Page 2 of the Price is Right Dice Game, in this case the player had to select higher or lower in the 1000s, 100s and 1s places because the 3, 4, and 5 of the dice did not match the 4, 6, and 8 digits, respectively; player has to select last digit as higher or lower than five rolled on dice or prediction symbol in ones place of car price on Page 2, player correctly selected higher so 8 digit is revealed to player; game repeated until all digits are revealed and prize awarded to player in the event the player got all of the digits right, Pages 2 and 3).

14. As to Claim 21: Dice Game on Page 2 shows the 6 in the tens place being revealed by the six on the dice (prediction symbol) matching the actual value of that digit.
15. As to Claim 22: The component symbols in Dice Game are from a range of numbers (higher or lower than the dice prediction symbol, Page 2).
16. As to Claim 23: The plurality of component symbols in Dice Game form a target symbol (plurality of digits forming the price of the car, Page 2).
17. As to Claim 25: As outlined regarding Claim 1, '369 and Dice Game teach a gaming device comprising: a primary game operable upon a wager by a player; a plurality of symbols; a plurality of component symbols, wherein each component symbol is one of said plurality of symbols; a plurality of symbol sets, wherein each symbol set includes zero, one or a plurality of said symbols; a plurality of different modifiers; a triggering event associated with said primary game, wherein after the occurrence of said triggering event at least one of said component symbols is selected and for each selected component symbol: (a) one of said plurality of symbols is designated as a prediction symbol; (b) said designated prediction symbol is displayed to the player; (c) an award based on said selected component symbol and one of the modifiers is provided to the player if said prediction symbol matches said selected component symbol, wherein each time said prediction symbol matches said selected component symbol the award is based on a different one of said modifiers; and (d) if said prediction symbol does not match said selected component symbol: (i) at least two of said symbol sets are formed based on said prediction symbol, wherein one of said

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symbols sets includes the selected component symbol; (ii) the symbols from the symbol set including the selected component symbol are displayed; (iii) the player is enabled to try to pick the selected component symbol by picking one of the displayed symbols; (iv) the selected component symbol is displayed to the player; and (v) said award is provided to the player if the player correctly picked the selected component symbol (top and bottom rows of digits, Pages 1 and 2; plural dice Pages 1 and 2; first symbol selected, Page 2; dice rolled, Page 2; dice displayed, Page 2; thousands place revealed to player if dice matches digit for that price Page 2, the digit is a X1000 modifier since it is a thousands decimal place in the price of a car, in this case the 3 would have been revealed to the player in the thousands position if the car were in the \$3,000 to \$3,999 range, but it was not so in this case the player had to select higher or lower than three and correctly selected higher so a four was shown in the thousands place; in the example of Page 2 the prediction symbol or dice correctly predicted the component symbol or 6 in the tens place to the player did not have to select higher or lower; process repeated and hundreds place revealed to player if dice matches digit for that price Page 2; player must select from higher or lower as outlined above concerning Page 2 of the Price is Right Dice Game, in this case the player had to select higher or lower in the 1000s, 100s and 1s places because the 3, 4, and 5 of the dice did not match the 4, 6, and 8 digits, respectively; player has to select last digit as higher or lower than five rolled on dice or prediction symbol in ones place of car price on Page 2, player correctly selected higher so 8 digit is revealed to player; game repeated until all

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digits are revealed and prize awarded to player in the event the player got all of the digits right, Pages 2 and 3).

18. As to Claim 26: Dice Game on Page 2 shows the 6 in the tens place being revealed by the six on the dice (prediction symbol) matching the actual value of that digit.

19. As to Claim 27: As outlined regarding Claim 1, '369 and Dice Game teach a gaming device comprising: a plurality of numbers, wherein each of said numbers is from a range of numbers; a plurality of number sets, wherein each number set includes zero, one or a plurality of said numbers; a target number formed from a plurality of component numbers, wherein each component number is one of said plurality of numbers; a plurality of modifiers; a display device; and a processor operable with said display device to determine said target number, to select at least one of said component numbers of said determined target number and for each selected component number to: (a) designate one of said plurality of numbers as a prediction number, (b) display said designated prediction number to a player; (c) provide an award to the player based on said selected component number and one of said modifiers if said prediction number matches said selected component number, wherein a greater one of said modifiers is used for each provided award, and (d) if said prediction number does not match said selected component number: (i) form one of said number sets based on said prediction number, wherein said number set includes the selected component number, (ii) enable the player to pick one of the numbers from the formed number set including the selected component number, (iii) display the selected component number, and (iv) provide the

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player the award if the player picks the selected component number (top and bottom rows of digits, Pages 1 and 2; plural dice Pages 1 and 2; first symbol selected, Page 2; dice rolled, Page 2; dice displayed, Page 2; thousands place revealed to player if dice matches digit for that price Page 2, the digit is a X1000 modifier since it is a thousands decimal place in the price of a car, in this case the 3 would have been revealed to the player in the thousands position if the car were in the \$3,000 to \$3,999 range, but it was not so in this case the player had to select higher or lower than three and correctly selected higher so a four was shown in the thousands place; in the example of Page 2 the prediction symbol or dice correctly predicted the component symbol or 6 in the tens place to the player did not have to select higher or lower; process repeated and hundreds place revealed to player if dice matches digit for that price Page 2; player must select from higher or lower as outlined above concerning Page 2 of the Price is Right Dice Game, in this case the player had to select higher or lower in the 1000s, 100s and 1s places because the 3, 4, and 5 of the dice did not match the 4, 6, and 8 digits, respectively; player has to select last digit as higher or lower than five rolled on dice or prediction symbol in ones place of car price on Page 2, player correctly selected higher so 8 digit is revealed to player; game repeated until all digits are revealed and prize awarded to player in the event the player got all of the digits right, Pages 2 and 3).

20. As to Claim 28: As outlined regarding Claim 1, '369 and Dice Game teach a gaming device comprising: a plurality of component numbers; a plurality of prediction numbers; a display device; and a processor operable with said display device to: (a) select one of said component numbers; (b) designate one of said plurality of prediction

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numbers; (c) display said designated prediction number to a player; (d) change a first modifier based on said displayed prediction number; (e) change a second modifier if said prediction number matches said selected component number; (f) if said prediction number does not match said selected component number: (i) form at least two number sets based on said prediction number, wherein one of said sets includes the selected component number; (ii) enable the player to input a prediction of which formed number set includes the selected component number; (iii) reveal the selected component number to the player; and (iv) change a third modifier if the player correctly picked which number set includes the selected component number; (g) repeat steps (a) to (f) until each of said component numbers is revealed; and (h) provide the player an award based on said first modifier, said second modifier and said third modifier (top and bottom rows of digits, Pages 1 and 2; plural dice Pages 1 and 2; first symbol selected, Page 2; dice rolled, Page 2; dice displayed, Page 2; thousands place revealed to player if dice matches digit for that price Page 2, the digit is a X1000 modifier since it is a thousands decimal place in the price of a car, in this case the 3 would have been revealed to the player in the thousands position if the car were in the \$3,000 to \$3,999 range, but it was not so in this case the player had to select higher or lower than three and correctly selected higher so a four was shown in the thousands place; in the example of Page 2 the prediction symbol or dice correctly predicted the component symbol or 6 in the tens place to the player did not have to select higher or lower; process repeated and hundreds place revealed to player if dice matches digit for that price Page 2; player must select from higher or lower as outlined above concerning

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Page 2 of the Price is Right Dice Game, in this case the player had to select higher or lower in the 1000s, 100s and 1s places because the 3, 4, and 5 of the dice did not match the 4, 6, and 8 digits, respectively; player has to select last digit as higher or lower than five rolled on dice or prediction symbol in ones place of car price on Page 2, player correctly selected higher so 8 digit is revealed to player; game repeated until all digits are revealed and prize awarded to player in the event the player got all of the digits right, Pages 2 and 3).

21. As to Claim 47: '369 teaches a method of operating a gaming device (Figs. 1, 2; 4:50-5:15). Dice Game teaches (a) selecting one of a plurality of component symbols; (b) generating a prediction symbol; (c) displaying said prediction symbol; (d) providing an award to a player if the generated prediction symbol matches the selected component symbol, wherein said award is based on said selected component symbol and a modifier; (e) if the generated prediction symbol does not match the selected component symbol: (i) forming a symbol set based on the generated prediction symbol, wherein said symbol set includes the selected component symbol; (ii) displaying said symbol set that includes the selected component symbol; (iii) enabling the player to pick one of the symbols from the symbol set which includes the selected component symbol; and (iv) providing the player the award if the player's picked symbol is the selected component symbol; (f) revealing the selected component symbol; and (g) repeating steps (a) to (f) until each component symbol is revealed, wherein the modifier that each subsequent award is based on is greater than the modifier that each previous award is based on (top and bottom rows of digits, Pages 1 and 2; plural dice Pages 1 and 2; first

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symbol selected, Page 2; dice rolled, Page 2; dice displayed, Page 2; thousands place revealed to player if dice matches digit for that price Page 2, the digit is a X1000 modifier since it is a thousands decimal place in the price of a car, in this case the 3 would have been revealed to the player in the thousands position if the car were in the \$3,000 to \$3,999 range, but it was not so in this case the player had to select higher or lower than three and correctly selected higher so a four was shown in the thousands place; in the example of Page 2 the prediction symbol or dice correctly predicted the component symbol or 6 in the tens place to the player did not have to select higher or lower; process repeated and hundreds place revealed to player if dice matches digit for that price Page 2; player must select from higher or lower as outlined above concerning Page 2 of the Price is Right Dice Game, in this case the player had to select higher or lower in the 1000s, 100s and 1s places because the 3, 4, and 5 of the dice did not match the 4, 6, and 8 digits, respectively; player has to select last digit as higher or lower than five rolled on dice or prediction symbol in ones place of car price on Page 2, player correctly selected higher so 8 digit is revealed to player; game repeated until all digits are revealed and prize awarded to player in the event the player got all of the digits right, Pages 2 and 3).

22. As to Claim 48: Dice Game on Page 2 shows the 6 in the tens place being revealed by the six on the dice (prediction symbol) matching the actual value of that digit.

23. As to Claims 49 and 50: '369 teaches providing a game through a network which can be the Internet (6:5-19).

24. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dice Game and '369 in view of Scarne.

25. As to Claim 24: '369 and Dice Game lack in initially displaying one of the components numbers, but this would have been obvious to one of ordinary skill in the art at the time the invention was made in light of Scarne ("Scarne's Encyclopedia of Card Games," by John Scarne, 1973, HarperCollins, Pages 9 and 10 discussing wild cards in poker and Page 282 discussing dealing one card face up to each player and the dealer). Poker and blackjack are both analogous to Dice Game in that the player is attempting to obtain a winning combination of indicia. Wheel of Fortune also teaches allowing players to buy a vowel (an initial display of certain indicia in a target combination), which is analogous

(<http://web.archive.org/web/20040812155927/http://www.wheeloffortuneinfo.com/index.html>). U.S. patent 5,788,573 A to the applicants (102(b)) teaches applying a game show as a bonus game in a wagering machine. The advantage of this combination would be to give the players a better chance at obtaining the winning combination of indicia, namely the correct price of the car in the Dice Game. This would serve to mitigate caused by the rule of the game being lost by one incorrect guess (Page 1, dice game).

Allowable Subject Matter

26. Claims 5 to 7, 12 to 14, 29 to 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Increasing the modifiers based on the prediction symbol matching the component symbol is not possible in regard to the Dice Game reference as the player is trying to guess the fixed price of the car. It would not be possible to increase the price of the car.

Election/Restrictions

27. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 32 to 39, drawn to a game which allows a player to select from indicated symbols in a symbol set and providing a prize to a player if the player selects the correct symbol, classified in class 463, subclass 16.
 - II. Claims 1 to 14, 20 to 31, and 47 to 50, drawn to a game in which a predictor symbol guesses a symbol for a player and the player is allowed to guess which range of values the symbol lies in if the prediction symbol was incorrect, classified in class 463, subclass 16.
 - III. Claims 15 to 19 and 40 to 46, drawn to a game with a prediction number modifier, a match modifier, and a correct prediction modifier, classified in class 463, subclass 16.

The inventions are distinct, each from the other because of the following reasons:

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28. Inventions I, II, and III are directed to related games. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed: I pertains to a general indicia selection game which could possibly be roulette, keno, lottery, or even slots or poker. II pertains to a game which allows a player to guess whether a symbol's value is within one of two ranges if the player's initial guess of the symbol's value is incorrect. III pertains to a game with a prediction number modifier, a match modifier, and a correct prediction modifier, and so is rather different from the other two types of games. All of these games are independently usable. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

29. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

30. During a telephone conversation with Adam Masia on 8-8-2007 a provisional election was made without traverse to prosecute the invention of II, Claims 1-14, 20-31, and 47-50. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 15-19, 32-46, and 51-56 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

31. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

33. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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